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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 10/017,640 | 12/14/2001 | William R. Matz | 36968/265387 | 9378 |
| 23552 | 7590 | 12/30/2003 | EXAMINER | |
| MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903 | | | OUELLETTE, JONATHAN P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|-----------------------------|--|---------------------------------|
| Offic Action Summary | Applicati n N . | Applicant(s) |
| | 10/017,640 Examiner Jonathan Ouellette | MATZ ET AL. Art Unit 3629 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Pri rity under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. **Claims 1, 6, 10-13, 16-18, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable by Carles (US 5,661,516) in view of Eldering et al. (US 2002/0123928 A1).**
3. As per independent Claims 1, 16, 17, and 25, Carles discloses a method (computer-readable medium, system) for utilizing information relating to a subscriber to identify said subscriber as a desirable subscriber (Abstract) comprising: receiving advertising and programming data (C3 L16-62, “library of commercial messages”); receiving a subscriber attribute (data about the subscriber) (C3 L16-62, “household database”); merging the advertising and programming data and said subscriber attribute to create a subscriber information data store; and analyzing said subscriber information data store to determine said subscriber’s desirability in relation to a provider (C8 L57-64, Claim 4).
4. Carles fails to expressly disclose receiving content-access information associated with a subscriber (viewing information associated with the subscriber).

5. Eldering teaches receiving content-access information associated with a subscriber, and using the information to generate a subscriber profile and to generate targeted advertising based on the generated subscriber profile (Abstract, Para 0024-0025).
6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving content-access information associated with a subscriber (viewing information associated with the subscriber) as disclosed by Eldering, and merging (correlate) the content-access information with the advertising and programming data and said subscriber attribute to create a subscriber information data store, in the system disclosed by Carles, for the advantage of providing a method (computer-readable medium, system) for utilizing information relating to a subscriber to identify said subscriber as a desirable subscriber, with the ability to increase effectiveness of the system by incorporating detailed attributes into the subscriber profile, in order to better target advertising.
7. As per Claim 6, *Carles* and Eldering disclose wherein said subscriber attribute comprises demographic information.
8. As per Claim 10, *Carles* and Eldering disclose wherein said subscriber attribute comprises a purchase.
9. As per Claim 11, *Carles* and Eldering disclose wherein said purchase comprises a purchase of a product, wherein said product complements a product provided by said provider.

10. As per Claim 12, *Carles* and *Eldering* disclose wherein said purchase comprises a purchase of a product, wherein said product competes with a product provided by said provider.
11. As per Claim 13, *Carles* and *Eldering* disclose wherein said provider comprises a content provider.
12. As per Claim 18, *Carles* and *Eldering* disclose wherein said subscriber attribute database comprises a purchase history database.
13. **Claim 2-5, 7-9, 14, 15, and 19-24 are rejected under 35 U.S.C. 103 as being unpatentable over Carles in view of Eldering.**
14. As per Claim 2, *Carles* and *Eldering* do not expressly show wherein said subscriber comprises a consumer.
15. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of subscriber used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have performed the method (computer-readable medium, system) on a consumer subscriber, because such data does not functionally relate to the steps in

the method claimed and because the subjective interpretation of the subscriber does not patentably distinguish the claimed invention.

17. As per Claims 3-5, Carles and Eldering do not expressly show wherein said content-access information comprises television programming data, advertising data, and duration information.
18. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of content-access information used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using television programming data, advertising data, and duration information as the content-access information, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the content-access information does not patentably distinguish the claimed invention.
20. As per Claims 7 and 8, Carles and Eldering do not expressly show wherein said demographic information comprises a profession of said subscriber or a property ownership history of said subscriber.

21. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of demographic information used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a profession of said subscriber or a property ownership history of said subscriber as the demographic information, because such information does not functionally relate to the steps in the method claimed and because the subjective interpretation of the demographic information does not patentably distinguish the claimed invention.
23. As per Claim 9, Carles and Eldering do not expressly show wherein said subscriber attribute comprises a questionnaire response.
24. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of subscriber attribute used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381,

1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a questionnaire response as a subscriber attribute, because such an attribute does not functionally relate to the steps in the method claimed and because the subjective interpretation of the subscriber attribute does not patentably distinguish the claimed invention.
26. As per Claims 14 and 15, Carles and Eldering do not expressly show wherein said content provider comprises a programming provider or an advertising provider.
27. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of content provider used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a programming provider or a advertising provider as a content provider, because such data does not functionally relate to the steps in the method claimed and because the subjective

interpretation of the content provider does not patentably distinguish the claimed invention.

29. As per Claim 19, Carles and Eldering do not expressly show wherein said purchase history database comprises a credit card database.

30. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of purchase history database used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a credit card database as a form of purchase history database, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the purchase history database does not patentably distinguish the claimed invention.

32. As per Claims 20 and 21, Carles and Eldering do not expressly show wherein said subscriber attribute database comprises a property ownership database or a survey results database.

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33. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of subscriber attribute database used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a property ownership database or a survey results database as a subscriber attribute, because such an attribute does not functionally relate to the steps in the method claimed and because the subjective interpretation of the subscriber attribute database does not patentably distinguish the claimed invention.

35. As per Claims 22-24, Carles and Eldering do not expressly show wherein said data analyzer comprises a report creator, a multidimensional database, or a data-mining application.

36. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (computer-readable medium, system) for utilizing information relating to a subscriber, to identify said subscriber as a desirable subscriber would be performed regardless of the type of data analyzer used. Thus, this descriptive material will not distinguish the claimed invention

from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

37. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method (computer-readable medium, system) using a report creator, a multidimensional database, or a data-mining application as a data analyzer, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data analyzer does not patentably distinguish the claimed invention.

Response to Arguments

38. Applicant's arguments filed 9/30/2003, with respect to Claims 1-25, have been considered but are moot in view of the new ground(s) of rejection.

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

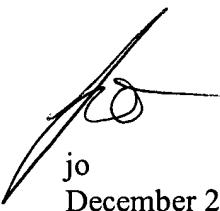
40. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

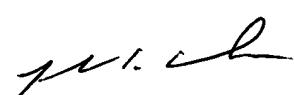
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
43. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.


jo
December 22, 2003



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600